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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,988	11/17/2003	Tianbao Lu	3DP-0542	2277
23377	7590	11/30/2004	EXAMINER	
WOODCOCK WASHBURN LLP ONE LIBERTY PLACE, 46TH FLOOR 1650 MARKET STREET PHILADELPHIA, PA 19103			JONES, DAMERON L	
			ART UNIT	PAPER NUMBER
			1616	

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/714,988	LU ET AL.	
	Examiner	Art Unit	
	D. L. Jones	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/22/04; 6/28/04; 2/27/04; & 11/17/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 93-108 and 110-146 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 146 is/are allowed.
- 6) ☒ Claim(s) 93-108 and 110-145 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2/27/04</u> . | 6) <input type="checkbox"/> Other: _____ |

ACKNOWLEDGMENTS

1. The Examiner acknowledges receipt of the following:
 - a. the amendment filed 11/17/03 wherein the specification was amended; claims 1-92 and 109 were canceled; claims 97 and 104 were amended; and claims 110-146 were added;
 - b. the amendment filed 6/28/04 wherein the specification was amended; and
 - c. the amendment filed 10/22/04 wherein claims 1-92 and 109 are canceled.

Note: Claims 93-108 and 110-146 are pending.

APPLICANT'S INVENTION

2. Applicant's election is directed to compositions and uses thereof as set forth in independent claims 93, 136, and 146.

RESPONSE TO APPLICANT'S ELECTION

3. Applicant's election with traverse of Group I (claims 93-108 and 110-146) is acknowledged. In addition, Applicant's election of the species 3-(3-methylphenylsulfonyl)amino-6-methyl-1[2-guanidinooxyethyl]aminocarbonylmethyl]2-pyridinone (Example 5) is acknowledged. The traversal is on the ground(s) that searching the full scope of the invention is not a serious burden to the Examiner and that Groups II and III classify similarly. This is found non-persuasive because the Het groups are structurally different and thus, classify differently depending on the number of nitrogens and doubled oxygen groups attached to the heterocycle. Thus, the core structure varies. As a result, a search of one group would neither anticipate nor render obvious another group. Therefore, a burdensome search is necessary to search the full

Art Unit: 1616

scope of the instant invention. Furthermore, while Applicant argues that Groups II and III are similarly classified. It should be noted that the subclasses are different and the number of doubled oxygen groups attached thereto is different. Hence, the restriction requirement is still deemed proper and is therefore made FINAL.

Note: Initially, Applicant's elected species was searched. However, since no prior art was found that could be used to reject the elected species, the search was expanded over the full scope of Group I.

DOUBLE PATENTING REJECTIONS

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 93-108 and 110-145 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24, 32, and 33 of U.S. Patent No. 6,566,379. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to compositions comprising Formula VII wherein the heterocyclic ring contains a 6-membered ring with one nitrogen group and a single double bonded oxygen attached to the ring. The claims differ in that the composition of the instant invention incorporates the intended use of the diagnostic composition. However, for product claims, the intended use is not given patentable weight. Thus, both disclose overlapping components.

6. Claims 93-108 and 110-145 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-37 of U.S. Patent No. 6,037,356. Although the conflicting claims are not identical, they are not patentably distinct from each other because a composition is obvious over its corresponding compound. The claims differ in that the patented claims are directed to a compound and the instant invention is directed to a composition comprising the patented compound and a pharmaceutically acceptable carrier. It would be obvious to one of ordinary skill in the art to add a carrier to a compound (Ex parte Douos, 163

Art Unit: 1616

USPQ 667; PTO Bd. App. 1968). Furthermore, it is noted that a composition (i.e., a compound and carrier) would be allowable if no utility is disclosed for the old compound. However, it is noted that the abstract discloses utility of compound. Thus, the compound and composition are not distinguished over one another.

Note: It is noted that Applicant has incorporated intended use into the product (composition) claims. Applicant is reminded that the intended use in a product claim does not carry patentable weight. However, intended use does carry patentable weight in a method claim.

ALLOWABLE CLAIMS

7. Claim 146 is allowable over the prior art of record.

COMMENTS/NOTES

8. It should be noted that no prior art has been cited against Applicant's claims. However Applicant **must** address and overcome the double patenting rejections above. The claims are distinguished over the prior art of record because the prior art neither anticipates nor renders obvious compositions and a method of imaging thrombus as set forth in independent claims 93, 136, and 146. The closest art is Applicant's own work which is cited in the double patenting rejections above.

Note: Applicant is respectfully requested to cancel the non-elected subject matter.

Art Unit: 1616

9. Applicant is reminded that the recitation that an element is 'capable of' performing a function is not a positive claim limitation, but only requires the ability to so perform that function. Hence, such terminology does not constitute a limitation in any patentable sense (In re Hutchison, 69 USPQ 138). For examples, see claim 93, line 58; claim 97, line 5; claim 97, line 6; and claim 104, lines 5 and 7.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571) 272-0617. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on (571) 272-0887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. L. Jones
Primary Examiner
Art Unit 1616

November 24, 2004